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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/425,633	10/22/1999	MARK CHEE	A-68087-1/RMS/DCF	9821
7590	08/18/2004		EXAMINER FORMAN, BETTY J	
Astrid R. Spain McDermott, Will & Emery 4370 La Jolla Village Drive 7th floor San Diego, CA 92122			ART UNIT 1634	PAPER NUMBER
DATE MAILED: 08/18/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

9A.

Advisory Action

Application No.

09/425,633

Applicant(s)

CHEE ET AL.

Examiner

BJ Forman

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 30 July 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 23-26, 30, 31, 42-46, 48 and 50-52.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

BJ Forman
Primary Examiner
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Continuation of Advisory Action:

Applicant argues that *In re Aller* fails to support a motivation to combine Nikiforov and Weisburg because *In re Aller* addressed differences in concentration or temperature. Applicant asserts that issues of concentration or temperature are not relevant to the instant claims and therefore *In re Aller* is not relevant. Applicant's assertion that *In re Aller* is inappropriate is acknowledged, but is not found persuasive. While *In re Aller* discusses concentration and temperature, Applicant has not cited any passage within the decision stating that the opinion is relevant only to concentration and temperature optimization.

Applicant argues that because Weisburg does not use the word "optimization", they do not teach or suggest optimizing conditions. The argument has been considered but is not found persuasive. The cited passage clearly and repeatedly teaches their method of two-step hybridization is preferred because it "facilitates hybridization" of the probe to target and probe to probe and desired.

Applicant asserts that the office has not provided "essential evidentiary component of an obviousness holding" which is defined as "some suggestion, motivation or teaching in the prior art". Applicant's assertion is acknowledged. However, the office has repeatedly cited teachings in the references suggesting the combination.

Applicant asserts that, absent the required evidentiary showing, the office is relying of hindsight reasoning. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argues asserts the number of probes required in the combination of Weisburg and Nikiforov would differ from the claimed invention because the combination would be inoperable. The argument has been considered but is not found persuasive because the arguments are not factually supported by evidence.

The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration include statements regarding unexpected results, commercial success, solution of a long-felt need, **inoperability of the prior art**, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. (see (MPEP 716.01(c)).

Applicant reiterates previous arguments regarding commercial success. The arguments and declaration of Dr. Stuelpnagel have been fully addressed in previous actions.

Applicant argues the instant claims are not obvious over the '431 patent because a general assertion that the claim language encompasses detection fails to support the obviousness rejection. Applicant asserts that the claims differ in that the '431 claims are directed to target sequence detection while the instant claims are directed to detection of a nucleotide. The argument has been considered but is not found persuasive because both methods recite steps of detecting a ligation product. The methods differ in that the instant claims state that the

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ligation product identifies the nucleotide. Both methods recite the same method steps. Hence, the methods are not patentably distinct.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (571) 272-0741. The examiner can normally be reached on 6:00 TO 3:30.

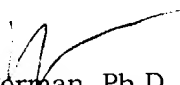
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.


BJ Forman, Ph.D.
Primary Examiner
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August 17, 2004